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IN THE

Supreme Court of the United States

OCTOBER TERM, 1979

No. 79-1175

WM. T. BURNETT & COMPANY, INC.,

Petitioner,

v.

THE GENERAL TIRE & RUBBER COMPANY,

Respondent.

On Petition for a Writ of Certiorari to the United States Court of Appeals for the Fourth Circuit

GENERAL'S RESPONSE TO BURNETT'S REPLY BRIEF

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Analysis of Burnett's argument, in its Reply, demonstrates that it is without merit.

Burnett's argument is based on the contention that

> ". . . General's fraud included the non-disclosure and misrepresentation of the advantages of using the *liquid* blowing agents, the Burnett invention, and that Burnett attributed its loss of priority to that invention to General's fraud. (Petitioner's Reply, p. 2) (emphasis added)

This attribution is without basis. Burnett argues that it was the first to use *liquid* chlorofluoro-alkanes as blowing agents. Burnett, however, can not, and does not challenge the fact that General, prior to Burnett, used *gaseous* cholorofluoro-alkanes as blowing agents. Thus, it is undisputed that General was the first to use a chlorofluoro-alkane as a blowing agent. It was this issue, namely who was first to use a chlorofluoro-alkane as a blowing agent, regardless of whether it was gaseous or liquid, that was before the Board of Patent Interferences and was decided by that Board in 1966.

The question before the Board of Patent Interferences was who was the first to make the invention *defined by the count* of the interference. The count called for the use of a "chlorofluoro-alkane"' which is volatilized during the foaming reaction (i.e., used as a blowing agent) (RA-5). The count made no distinction as to whether the blowing agent was, at room temperature, a *liquid* chlorofluoro-alkane or a *gaseous* chlorofluoro-alkane. Either satisfied the count.

Thus, the advantages, if any, of *liquid* chlorofluoro-alkanes as blowing agents was irrelevant to the issue before the Board—to wit, who was the first to make the invention directed to use of a chlorofluoro-alkane as the blowing agent.

Indeed, Klesper argued that the count *required* use of a liquid chlorofluoro-alkane and that use of a gas would not satisfy the count (RA-10). The Board specifically rejected Klesper's argument (RA-11):

> "We are of the view that a process wherein the chlorofluoroalkane is volatilized (during the foaming reaction) from a solution or liquid dispersion thereof is clearly within the scope of the count. All that is required in this respect is that the chlorofluoroalkane be volatilized 'during the foaming operation'. This is certainly taught in Frost application Serial Number 541,823."

This makes clear that the Board of Patent Interferences held that the essence of the invention was the use of a *chlorofluoro-alkane* as the blowing agent in the foaming reaction. It made no difference, insofar as the invention of the count was concerned, whether the blowing agent was liquid or gaseous. Either satisfactorily met the invention as set forth in the count. Under these circumstances, the alleged fraud of withholding information with regard to advantages of high boiling liquids could not have affected the outcome of the decision of the Board.

Insofar as the invention defined by the count is concerned, which is the sole subject matter involved in the interference, Burnett was not first and was not entitled to a patent under 35 U.S.C. § 102(g) as the Board of Patent Interferences specifically found on the facts presented in the interference proceeding. Under these circumstancs, Burnett could not have lost such patent rights, because it was not entitled to them *ab initio*.

If Burnett believed that chlorofluoro-alkanes which were liquid at room temperatures, were separately patentable over the broad invention directed to use of a chlorofluoro-alkane as the blowing agent, then the proper time to have made that argument was in Burnett's *ex parte* prosecution of its application after it was returned to the Examiner. There, Burnet had the unimpeded opportunity to present claims limited to use of the *high boiling liquid chlorofluoro-alkanes* and the opportunity to present its own evidence to convince the patent examiner that such high boiling liquids were patentably distinct over the generic invention awarded to Frost. *Application of Taub*, 348 F.2d 556, 560-561 (C.C.P.A. 1965).

The record is silent as to whether Burnett attempted to do this, but in any event his *ex parte* application was rejected. See Point II of "Respondent's Brief in Opposition to Petition."

Res judicata is properly applicable to Burnett's attempt to relitigate the issue decided by the Board of Patent Interferences in 1966. The alleged fraud could not, as a matter of law, have affected the outcome of that decision holding that Burnett's employee, Klesper, was not the first to use a chlorofluoro-alkane as a blowing agent.

CONCLUSION

Burnett's Petition should be denied.

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Respectfully submitted,

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